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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,720	12/28/2000	Isao Yagasaki	826.1658	6774

21171 7590 03/22/2005
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EXAMINER

BORISOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,720

Applicant(s)

YAGASAKI ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

Amendment received on 12/17/2004 is acknowledged and entered. Claims 8, 14 and 17-19 have been amended. Currently claims 1-19 are pending for examination.

Claim Rejections - 35 USC § 101

Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

Examiner Note

Applicant is advised that should Claims 9-10 and 18-19 be found allowable, Claims 9-10 and 18-19 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Specifically, Claim 18 recites a computer accessible transfer medium supplying a program to a computer, which can be understood as a computer-readable recording medium of Claim 9, on which a program for a computer is recorded. In this case both Claims 9 and 18 are identical.

Claim 19 recites a computer accessible transfer medium supplying a program to a computer, which can be understood as a computer-readable recording medium of Claim 10, on which at least one program for a computer is recorded. In this case both Claims 10 and 19 are identical.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peirce et al. (US 6,332,126 B1) (hereinafter Pierce) in view of Spiegel et al. (US 6,466,918 B1) (hereinafter Spiegel).

Claim 4. Pierce teaches a targeted payment system, comprising: a storing device for storing a plurality of target criteria (qualifying information) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a receiving device for receiving qualifying information from a user (C. 3, L. 10-15); a first determining device for determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 30-36); a second determining device for determining that the user possesses qualifying information including historic purchase activity for the second service when the user is utilizing the first service (C. 6, L. 14-54); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Pierce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Pierce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity. Information as to *by referring to the membership qualification table of the second service ... of the second service* is given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of

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structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 4 are disclosed in Pierce in view of Spiegel as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 1. Pierce teaches said system, further comprising storing means for storing a plurality of target criteria (qualifying information) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a receiving device for receiving qualifying information from a user (C. 3, L. 10-15); a selecting device, and a presenting device (C. 3, L. 10-45), wherein the selecting device determines whether a user is utilizing a first service when determining if the user eligible for a second service; and that the user possesses qualifying information for the second service when the user is utilizing the first service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); and wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

Claim 2. Pierce teaches said selecting device as in claim 1. Information as to *said device totals membership conditions of the at least two services using an AND operation and compares ...* is given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Thus the structural limitations of claim 2 are disclosed in Pierce in view of Spiegel as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 3. Pierce teaches: a device for defining a target criteria for specified services (C. 3, L. 11-12); the receiving device for receiving qualifying information from a user (C. 3, L. 10-15); and a selecting device for selecting specified services based on the received qualifying information of the user (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45):

Claim 5. Pierce teaches: a monitoring device for monitoring user purchasing activity (C. 2, L. 35-46); the receiving device for receiving qualifying information from a user (C. 3, L. 10-15); and the first determined device for determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15).

Claim 6. Peirce teaches a targeted payment system, comprising: a storing device for storing a plurality of target criteria (qualifying information) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a designating device for designating a specified target criteria including users historic purchase activity (C. 3, L. 10-15; C. 6, L. 43-45); a monitoring device for monitoring qualifying information of users; a determining device for determining users eligible for the specified target criteria (C. 3, L. 10-15); and the presenting device for presenting information about a specified service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the

purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity. Information as to *by referring to the membership qualification table of the second service ... of the second service* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 6 are disclosed in Pierce in view of Spiegel as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 7. Pierce teaches: monitoring device for monitoring qualifying information of users to determine users eligible for the specified target criteria, and a determining device for determining users eligible for the specified target criteria (C.2, L.60-67; C. 3, L. 10-15). Information as to *adds certificate information..., counts a number of the pieces of certificate information..., obtains the number of users who can become the members of the other service...* is given no patentable weight.

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 7 are disclosed in Pierce in view of Spiegel as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 9. Peirce teaches a computer-readable recording medium containing instruction causing a computer to perform a method for a targeted payment discount program, comprising: determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); storing identification information including historic purchase activity of the first service as qualification criterion information for comparing with qualifying information of the second service (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45); determining that the user possesses qualifying information including historic purchase activity for the second service when the user is utilizing the first service (C. 6, L. 14-54); presenting qualification information about said selected service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership

benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 8. Peirce teaches: in response to detected user's activity, determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); storing identification information (historic purchase activity) of the first service as qualification criterion information for comparing with qualifying information of the second service (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45); determining that the user possesses qualifying information for the second service when the user is utilizing the first service (C. 6, L. 14-54); presenting qualification information about said selected service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

Claim 10. Peirce teaches a computer-readable recording medium containing instruction causing a computer to perform a method for a targeted payment system discount program, comprising: storing a plurality of target criteria (qualifying information) of the plurality of services; designating a specified target criteria (C. 3, L. 10-15; C. 6, L. 43-45); monitoring qualifying information of users to determine users eligible for the specified target criteria (C. 3, L. 10-15); presenting information about a specified service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase

activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 12. Peirce teaches a method for a targeted payment discount program, comprising: determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); storing identification information including a historic purchase activity of the first service as qualification criterion information for comparing with qualifying information of the second service (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45); determining that the user possesses qualifying information including a historic purchase activity for the second service when the user is utilizing the first service (C. 6, L. 14-54); presenting qualification information about said selected service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 11. Peirce teaches: storing a plurality of target criteria (qualifying information) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); comparing

qualifying current information of user's purchasing activity with the target criteria of said plurality of services which is not offered to the user yet; selecting a service to which the user is eligible based on said comparison (C. 2, L. 35 – C. 3, L. 60; C. 6, L. 14-54); presenting information about said selected service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

Claim 13. Peirce teaches a system and method for a targeted payment system discount program, comprising: storing a plurality of target criteria (qualifying information) of the plurality of services; designating a specified target criteria including historic purchase activity (C. 3, L. 10-15; C. 6, L. 43-45); monitoring qualifying information of users including historic purchase activity to determine users eligible for the specified target criteria (C. 3, L. 10-15); presenting information about a specified service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 15. Peirce teaches a targeted payment system, comprising: a storing means for storing a plurality of target criteria (qualifying information including historic purchase activity) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a receiving device for receiving qualifying information from a user including historic purchase activity (C. 3, L. 10-15); a first determining means for determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); a second determining means for determining that the user possesses qualifying information including historic purchase activity for the second service when the user is utilizing the first service (C. 6, L. 14-54); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Information as to *by referring to the membership qualification table of the second service ... of the second service* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the

claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 4 are disclosed in Pierce in view of Spiegel as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 14. Pierce teaches said system, further comprising: storing means for storing a plurality of target criteria (qualifying information) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a receiving device for receiving qualifying information from a user (C. 3, L. 10-15); a selecting device, and a presenting device (C. 3, L. 10-45), wherein the selecting device determines whether a user is utilizing a first service when determining if the user eligible for a second service; and that the user possesses qualifying information for the second service when the user is utilizing the first service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); and wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

Claim 16. Peirce teaches a targeted payment system, comprising: a storing device for storing a plurality of target criteria (qualifying information including historic purchase activity) of the plurality of services (C. 3, L. 10-15; C. 6, L. 43-45); a designating device for designating a specified target criteria including historic purchase activity (C. 3, L. 10-15; C. 6, L. 43-45); monitoring device for monitoring qualifying information of users including historic purchase activity; a determining device for determining users eligible for the specified target criteria (C. 3, L. 10-15); and the presenting device for presenting information about a specified service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the

purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 18. Peirce teaches a computer-readable recording medium containing instruction causing a computer to perform a method for a targeted payment system discount program, comprising: determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); storing identification information including historic purchase activity of the first service as qualification criterion information for comparing with qualifying information of the second service (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45); determining that the user possesses qualifying information including historic purchase activity for the second service when the user is utilizing the first service (C. 6, L. 14-54); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership

benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Claim 17. Peirce teaches: in response to detected user's activity, determining whether a user is utilizing a first service when determining is the user eligible for a second service (C. 6, L. 14-54; C. 8, L. 43 – C. 9, L. 15); storing identification information (historic purchase activity) of the first service as qualification criterion information for comparing with qualifying information of the second service (C. 2, L. 35 – C. 3, L. 60; C. 4, L. 18 – C. 5, L. 45); determining that the user possesses qualifying information for the second service when the user is utilizing the first service (C. 6, L. 14-54); presenting qualification information about said selected service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

Claim 19. Peirce teaches a computer-readable recording medium containing instruction causing a computer to perform a method for a targeted payment system discount program, comprising: storing a plurality of target criteria (qualifying information including historic purchase activity) of the plurality of services; designating a specified target criteria including historic purchase activity (C. 3, L. 10-15; C. 6, L. 43-45); monitoring qualifying information of users including historic purchase activity to determine users eligible for the specified target criteria (C. 3, L. 10-15); presenting information about a specified service to the user (C. 3, L. 42-47); wherein said collected qualifying information is stored and organized in tables (C. 4, L. 20-27).

However, Peirce does not specifically teach that said qualifying information including historic purchase activity is *membership* qualification information.

Spiegel teaches a computer-implemented system and method for assisting users in locating popular products within a catalog of an online merchant, wherein the purchase history of a user is considered to be a qualifying condition for a membership (C. 2, L. 60-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce to include that said qualifying historic purchase activity of the user is considered to be membership qualification information, as disclosed in Spiegel, because it would allow to create a predetermined membership benefits and services to active shoppers, thereby stimulating other users to increase their shopping activity.

Response to Arguments

Applicant's arguments filed 12/17/2004 have been fully considered but they are not persuasive.

In respect to the applicant's argument that the cited prior art does not teach "a *qualification criterion information for qualifying membership of a corresponding service and defining a prescribed service of which a user ought to be a member to have a membership qualification for the corresponding service*" (claim 4, lines 4-6), it is noted that Peirce teaches determining whether a user is utilizing a first service when determining is the user eligible for a second service. Specific examples disclosed in Peirce include: *merchants ... target cardholders based on travel data, i.e., the number of trips to a particular destination airport per quarter; or based on their response rate to prior Program offers, specifically the number of responses to offers by quarter* (C. 6, L. 30-36).

In respect to the applicant's argument that In re Danly and Ex parte Masham are not applicable (Claim 4), the Examiner maintains that language as to "*by referring to the membership qualification table of the second service*" is directed to a method step and does not recite any structural limitation. So as claimed invention is directed to a system, said language is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

In respect to the applicant's argument that the cited prior art does not teach a *simulating device* as recited in Claim 6 (*simulating means* as in Claim 16), it is noted that Peirce discloses a monitoring device for monitoring qualifying information of users, and a determining device for determining users eligible for the specified target criteria, (C. 3, L. 10-15), which provide same functionality as a simulating device. Spiegel was applied to show that historic purchase activity, which is designated as a specified target criteria in Peirce, can be a membership qualification information (See: Spiegel, C. 2, L. 60-67 and discussion above).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571) 272-6801 after that date.

Art Unit: 3629.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist before April 13, 2005, whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702 before April 13, 2005, and (571) 272-6812 after that date.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

3/13/2005


DENNIS RUHL
PRIMARY EXAMINER